

PATENT

Attorney Docket No.: E4919-00003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Nowak et al.**

Examiner: **M. Jackson**

Serial No.: **09/178,329**

Group Art Unit: **1794**

Filed: **October 23, 1998**

Confirmation No.: **4360**

For: **COMPOSITE WRAP MATERIAL**

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF (37 CFR 41.41)

This Reply Brief is in response to the Examiner's Answer mailed on 6/8/10. This brief is being timely submitted under 37 CFR §41.41(a).

Respectfully Submitted,

Date: August 6, 2010

/Richard A. Paikoff/
Richard A. Paikoff, Reg. No. 34,892

Duane Morris LLP
30 South 17th Street
Philadelphia, PA 19103-4196
Telephone: 215-979-1853
Facsimile: 215-979-1020

Supplemental Remarks**VII. Argument**

In response to the Examiner's Answer (Answer), Appellants wish to help further clarify the differences between the presently claimed invention and the cited prior art.

35 U.S.C. § 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

All of the evidence must be considered under the Graham factors in reaching an obviousness determination. *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976) ("Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself."); *In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986) ("If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed.").

While the analysis under 35 U.S.C. § 103 allows flexibility in determining whether a claimed invention would have been obvious, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it still requires showing that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* A rejection for obviousness must include "articulated reasoning with some rational underpinning to support the legal conclusion." *Id.* at 418; quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). "We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention." *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008); Appeal 2010-00339, Application 10/850,075.

Please note that Appellants are arguing that it would not be obvious to combine the admitted prior art with Peer Jr., and in that sense, it is considered appropriate to describe the inapplicability of the teachings of Peer Jr. in combination with the admitted prior art.

The Board's attention is directed to the Abstract of Peer Jr., the first sentence of which states the following: "*A secondary container packaging material for use in six pack can wraps, six pack bottle carriers, twelve pack carriers, etc., comprising a composite of a paper material laminated to a plastic film.*" (emphasis added) As previously stated, Peer Jr. relates to a secondary container packaging material for use in six pack can wraps, six pack bottle carriers, twelve pack carriers, etc., comprising a composite of a paper material laminated to a plastic film. As stated at column 1, lines 10-20 of the reference:

*"The term 'secondary container packaging' as generally understood in the industry and as used herein refers to packaging used in conjunction with **primary** containers, such as cans or bottles, which contain the ultimate product, such as beer or other beverages. Secondary container packaging includes container wraps which surround and support the containers, basket bottle carriers having bottom and side supports for the containers and an upwardly extending handle, 12-pack rectangular carriers completely enclosing the containers, and labels for application to the containers."* (emphasis added)

There is no teaching or suggestion in the reference of the applicability of such material for use as primary packaging, i.e., as the packaging actually containing the ultimate product. In the present invention, the laminated composite wrap material wraps the ream of paper, i.e., it serves as the primary packaging for the reams of paper. The alternative embodiments that are referred to in the Examiner's Answer are not primary packaging; for instance, bottle labels as noted at column 7, line 15 of Peer Jr. are certainly not primary packaging, i.e., packaging containing the ultimate product.

Appellants respectfully contend that, contrary to the Examiner's contention at pages 5-6 of the Answer, there is no motivation in Peer Jr. "*to utilize a pre-formed polymer vs. a polymer coating in making polymer/paper composite packaging material given that the use of such pre-formed polymer film in the polymer/paper packaing material provides improved tear resistance and strength at lower cost as taught by Peer Jr...*" Peer Jr. is directed to secondary packaging for can wraps and bottle carriers; it is hindsight to equate such packaging with a wrapped ream of paper, as in the presently claimed invention. As previously stated, it is well established that if a

proposed modification or combination of the prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, modifying the invention of Peer Jr. so that the secondary packaging was the only packaging containing the ultimate product (e.g., beverage items) would result in a product unsuitable for its intended purpose. Therefore, prima facie obviousness is not established, and the rejection is overcome.

Furthermore, it is respectfully contended that in this case the specific “motivation” was provided by Appellants in Appellants’ disclosure, with Appellants’ disclosure now being used for a hindsight reconstruction of the invention.

In view of the foregoing remarks and the remarks set forth in the Appeal Brief, Appellants submit that all claim rejections should be reversed. Appellants submit that this application is in condition for allowance, and request early notification to that effect.